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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,272	01/18/2002	I. S. Au	2002231	7611
34018	7590	11/17/2004	EXAMINER	
GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			SAADAT, CAMERON	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/051,272

**Applicant(s)**

AU, I. S.

**Examiner**

Cameron Saadat

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/1/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12 is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

In response to the remarks filed 7/1/2004, claims 1-14 are pending in this application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-8, 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Herman et al. (USPN 5,364,272; hereinafter Herman).**

Regarding claims 1 and 13, Herman discloses an apparatus for determining the identification of selected objects for use in connection with an electronic children's toy, the apparatus comprising: a plurality of objects 14a-c which include a plurality of object contact elements 50a-h, wherein two or more of the contact elements are connected to form a contact pattern which serves to uniquely identify the object (Col. 4, lines 7-17); and an identification member 12a-c capable of being placed in physical contact with the object contact elements 50a-h (Col. 6, lines 42-56); the identification member including a plurality of member contact elements 46a-h configured such that at least two of the member contact elements come into electrical contact with at least two of the object contact elements when the identification member is placed in contact with one of the objects (Col. 4, lines 18-25); and a processing unit 20 in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 5, lines 46-51); (as per claim 13) passing an electrical current from the identification member to said object through the contact elements (Col. 4, lines 31-39).

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Regarding claims 2 and 14, Herman discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 20-23).

Regarding claim 3, Herman discloses an apparatus comprising a means of providing audio information includes computer-generated human speech (Col. 6, lines 42-56).

Regarding claim 4, Herman discloses an apparatus wherein audio information is provided upon movement of a portion of the apparatus (Col. 6, lines 42-56).

Regarding claim 5, Herman discloses an apparatus wherein the identification member includes at least three contact elements 46a-h arranged linearly (See Fig. 2).

Regarding claims 6, Herman discloses an apparatus wherein the objects 14a-c include at least two contact elements 50a-h arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements (Col. 3, line 63 – Col. 4, line 58).

Regarding claim 7, Herman discloses an apparatus wherein the identification member includes at least four contact elements 46a-h arranged in at least two linear rows. (See Fig. 2

Regarding claim 8, Herman discloses an apparatus wherein the objects 14a-c include at least two contact elements 50a-h arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements 46a-h (Col. 3, line 63 – Col. 4, line 58).

*Allowable Subject Matter*

Claims 9-12 are allowed. The following is an examiner's statement of reasons for allowance: Patentability is seen in, although not limited to: independent claim 9, the combination of elements specifically claimed including a fishing pole device including a rod member and a hook member; a plurality of objects having a plurality of object contact elements wherein two or more of the object contact elements are connected to one another to form a contact pattern which serves to uniquely identify

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each object; wherein the objects include an aperture configured to accept engagement of the hook member; an identification member associated with the hook member, wherein the identification member includes a plurality of member contact elements configured such that at least two of the member contact elements come into electrical contact with at least two of the object contact elements when the hook member is placed in physical contact with one of the objects; and a processing unit associated with the fishing pole, wherein the processing unit is in direct electrical contact with the identification member, the processing unit being capable of detecting the object contact pattern in physical contact with the identification member to identify the particular object in physical contact with the hook member. The closest prior art of record does not teach or fairly suggest this feature in the combination.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

Applicant's arguments filed 7/1/04 have been considered but they are not fully persuasive. Applicant purports that Herman fails to even remotely teach or suggest the formation of an electrical contact between conductive pads 46 and 50. Applicant identifies (Col. 4, lines 49-58) of Herman:

"The capacitive coupling allows the control signal transmitted from Sout to flow to Sin and to the predetermined set of code-out pads (50a, 50c and 50d) to become the data signal. The data signal is then capacitively coupled back to processor 20 through the corresponding code-in pads (46a, 46c and 46d). By determining from which code-out pads 50 and code-in pads 46 the data signal is coupled back to receptacle 12, processor 20 determines the identity of the datum which is facing up from cube 14 as it rests in receptacle 12."

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Applicant concludes that at no point does an electrical current ever pass between the conductive pads 46 and 50 as claimed in claims 1 and 13; and that it is impossible for an electrical current to pass between the conductive pads in view of the fact that they are separated by a dielectric layer.

First, is noted that claims 1-12 do not include the limitation of passing an electrical current between an object and an identification member. Independent claims 1 and 9 merely require the limitation of an identification member having a plurality of contact elements *come into electrical contact* with at least two contact elements of an object. There is no mention of passing an electrical current between the contact elements.

In addition, (Col. 4, lines 49-58, Herman), actually contradicts applicant's assertion that there is no electrical contact between pads 46 and 50. Herman discloses that capacitive coupling allows the control signal transmitted from Sout to flow to Sin and to the code pads 50, which are then capacitively coupled back to processor 20 through code in pads 46. By determining from which code-out pads 50 and code-in pads 46 *the data signal is coupled back to receptacle 12*, processor 20 determines the identity of the datum on cube 14 as it rests in receptacle 12. If there was no electrical contact formed between pads 46 and 50, there is no way that the data signal could be coupled back to the receptacle 12.

Furthermore, when contact elements 46 and 50 come together, a capacitor is formed. Herman states, "*The signal transmitted via this capacitance must be of a high enough frequency to endure the effective impedance of the capacitance. This effective impedance is give by:  $1/2\pi fC$ , where f is the signal frequency in Hertz*" (Col. 4, lines 31-39). Hence, it is clear that the signal transmitted via the capacitor is a time-varying signal in the frequency domain. Therefore, the current at the terminals of the capacitor is,  $i = C(dv/dt)$ . The capacitor formed with elements 46 and 50 does not behave as an open circuit as purported by applicant, since the signal transmitted via the capacitor is time-varying.

Applicant's arguments, with respect to claims 9-12 have been fully considered and are persuasive. The rejection of claims 9-12 has been withdrawn.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Soto et al. (US patent application publication 2003/0171063 A1) – disclose an educational toy comprising an identification member for identifying various objects.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 703-308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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XUAN M. THAI  
PRIMARY EXAMINER

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